



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,331	08/23/2001	Erhard Honig	24759	9981

7590 10/19/2004

Gary M. Nath
NATH & ASSOCIATES PLLC
6 Floor
1030 15th Street, N.W.
Washington, DC 20005

EXAMINER

MUSSER, BARBARA J

ART UNIT	PAPER NUMBER
----------	--------------

1733

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,331

Applicant(s)

HONIG, ERHARD

Examiner

Barbara J. Musser

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-22 is/are pending in the application.
- 4a) Of the above claim(s) 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Cakmakci(U.S. Patent 5,063,014).

Cakmakci discloses an apparatus for applying a plastic strip to a workpiece comprising an extruder for extruding a plastic strip and a roller for forming a desired profile in the extruded plastic strip having a projection(25E) and a recess(25A) which forms a desired profile by squeezing the plastic strip between the roller and the workpiece.(Figures 3 and 5) While this device does not extrude the strip on the edge of a plate-like workpiece, it is capable of doing so, and therefore meets the claim limitations.

Regarding claims 2 and 4, the support(35) can turn and move up and down, thus acting as a pressing means.(Figure 2)

3. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shanahan et al.(U.S. Patent 6,231,327).

Art Unit: 1733

Shanahan et al. discloses an apparatus for applying a plastic strip to the edge of a plate-like workpiece by extruding the plastic strip on the edge of the workpiece, and using a forming means having protrusions and recesses to form to form a desired profile via squeezing the plastic between the roller and the edge of the workpiece.(Figure 1)

Regarding claim 2, the reference shows moving the workpiece past the extruder.(Figure 1)

Regarding claim 4, since the workpiece is clamped and moved in relation to the forming roller, it is pressed against the forming roller as the two are pressed together for form the desired pattern.

The reference has a filing date prior to applicant's second foreign priority document but after applicant's first. A review of the earlier foreign priority document indicates the claims are not fully supported by it as the document does not indicate the plastic strip is applied to the edge of a plate-like workpiece or that the workpiece can comprise chip board, particle board, or a board made of wood-like particles. It is noted that if applicant uses an affidavit to antedate the reference, the reference would become a possible interference.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

Art Unit: 1733

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. as applied to claim 1 above, and further in view of Munro.

The reference cited above discloses a support means, clamping means, and movable members on which the extruder and forming means are transportable along the edge of the workpiece.(Figure 1) However, the reference does not disclose the workpiece is clamped to a stationary support or that the extruder and forming means are located on a single movable member. Munro discloses a device for applying an edge to a plate-like workpiece wherein the workpiece is stationary and both the extruder and forming means are located on a single movable member.(Abstract; Col. 7, ll. 67- Col. 8, ll. 3) It would have been obvious to one of ordinary skill in the art at the time the invention was made to clamp the workpiece to a stationary support and locate both the extruder and forming means are located on a single movable member since this would allow the device of Shanahan et al. to be made portable.(Abstract)

Regarding claim 9, Munro discloses applying a band of material to the adhesive laid down by the extruder.(Figure 1) It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a strip of material to the plastic of Shanahan et al. since this would allow the addition of materials which cannot be extruded, such as gold film or wood grained paper, to the edge of the workpiece.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. as applied to claim 1 above, and further in view of Nakata et al.

Art Unit: 1733

The reference cited above does not disclose applying a primer to the workpiece prior to applying the plastic strip. Nakata et al. discloses an apparatus for applying strip of material to the edge of a workpiece wherein primer can be applied to the window edge prior to application of the strip of material.(Col. 6, ll. 48-50) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an adhesive applicator to apply primer to the edge of the workpiece prior to applying the plastic strip as in Shanahan et al. since it is well-known and conventional in the arts to apply primers to better bond extruded plastic materials to substrates as shown for example by Nakata et al. which discloses applying a primer to the edge of a workpiece prior to applying an extruded plastic material to it.(Col. 6, ll. 48-50)

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. as applied to claim 1 above, and further in view of Hasenkamp et al.(WO98/04390). U.S. Patent 6,432,237 is considered an English language translation thereof, and all column and line numbers refer to it.

The reference cited above does not disclose cooling the strip after application of the decorative material. Hasenkamp et al. discloses it is known when applying thermoplastic to the edge of a workpiece to cool the material so that it does not penetrate too far into the edge of the workpiece.(Col. 3, ll. 16-23) It would have been obvious to one of ordinary skill in the art at the time the invention was made to cool the strip of material applied to the workpiece since this would prevent the material from penetrating too far into the workpiece.(Col. 3, ll. 16-23)

Art Unit: 1733

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. and Munro as applied to claim 1 above, and further in view of Hasenkamp et al.

The references cited above do not disclose cooling the strip after application of the decorative material. Hasenkamp et al. discloses it is known when applying thermoplastic to the edge of a workpiece to cool the material so that it does not penetrate too far into the edge of the workpiece.(Col. 3, ll. 16-23) It would have been obvious to one of ordinary skill in the art at the time the invention was made to cool the strip of material applied to the workpiece since this would prevent the material from penetrating too far into the workpiece.(Col. 3, ll. 16-23) While the reference is silent as to when the cooling takes place, one in the art would appreciate that the cooling would occur after application of the decorative material as otherwise the surface of the adhesive would have cooled too much to allow bonding of the decorative material to the extruded strip.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. as applied to claim 1 above, and further in view of Ecklund et al.

The references cited above do not disclose using a pair of driven rolls to move the workpiece relative to the edge bander. Ecklund et al. discloses it is known to move a workpiece past an extruder which extrudes material on the edge by using a pair of driven rolls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to move the workpiece past the extruder since the device of Nakata et al. would not work well with a material like wood which is not easier held by suction cups and since Ecklund et

Art Unit: 1733

al. discloses it is known to use driven rollers to move workpieces past an extruder.(Figure 1)

10. Claims 1, 3, 4, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro in view of Winterroth et al.(U.S. Patent 3,524,781)

Munro discloses an apparatus for applying a strip to the edge of a workpiece using a device which extrudes adhesive onto the edge of the workpiece. A strip of material is applied thereto and a roller(66, 98) conforms the strip and adhesive to the shape of the workpiece.(Col. 1, ll. 6-14; Col. 2, ll. 58-67; Col. 7, ll. 28-33) The rollers have a circumferential profile corresponding to the desired flat profile, and they squeeze the extruded material against the edge of the workpiece. While the claimed profile is not required to have a shape other than flat, it is noted that the edge of the workpiece can be curved,(Col. 7, ll. 38-41 and since the purpose of the edge bander is to form the material such that there is a regulated thickness between the band and the workpiece edge, one in the art would understand that the roller would also be curved, having the desired profile.

The reference does not disclose the forming roller having projections and recesses which form a pattern on the final product. Winterroth et al. discloses a roller which presses a plastic material against a substrate which has a pattern on the edge so that the material applied to the edge has a pattern.(Figure 2) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a forming roller with projections and recesses since this would allow formation of a pattern in the material applied to the edge and

Art Unit: 1733

since Winterroth et al. shows it is known to apply material to an edge using a roller which forms a pattern in the deposited material.

Regarding claim 3, Munro does not specifically disclose support means for the workpiece which clamp the workpiece to the support means. However, the reference does disclose that the device is intended to be movable about the workpiece and that the workpiece is placed on a table. (Abstract, Col. 7, ll. 67- Col. 8, ll. 3) It would have been obvious to one of ordinary skill in the art at the time the invention was made to clamp the workpiece to the table to prevent it moving while applying the edge strip.

Regarding claim 4, while the reference discloses pressing the forming means against the workpiece, one in the art would readily appreciate that an obvious alternative would be to press the workpiece against the forming means. Only the expected results would be achieved.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munro and Winterroth et al. as applied to claim 1 above, and further in view of Nakata et al.

The references cited above do not disclose moving the workpiece relative to the edge bander. Nakata et al. discloses it is known to move a workpiece past an extruder which extrudes material on the edge. It would have been obvious to one of ordinary skill in the art at the time the invention was made to move the workpiece past the extruder as this is an obvious alternative to moving the extruder as shown for example by Nakata et al. which discloses extruding a strip

Art Unit: 1733

onto the edge of a workpiece where the workpiece moves past the extruder.(Figure 7)

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munro and Winterroth et al. as applied to claim 1 above, and further in view of Nakata et al.

The references cited above do not disclose applying a primer to the workpiece prior to applying the plastic strip. Nakata et al. discloses an apparatus for applying strip of material to the edge of a workpiece wherein primer can be applied to the window edge prior to application of the strip of material.(Col. 6, ll. 48-50) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an adhesive applicator to apply primer to the edge of the workpiece prior to applying the plastic strip as in Munro and Winterroth et al. since it is well-known and conventional in the arts to apply primers to better bond extruded plastic materials to substrates as shown for example by Nakata et al. which discloses applying a primer to the edge of a workpiece prior to applying an extruded plastic material to it.(Col. 6, ll. 48-50)

13. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro and Winterroth et al. as applied to claims 1 and 9 above, and further in view of Hasenkamp et al.(WO98/04390). U.S. Patent 6,432,237 is considered an English language translation thereof, and all column and line numbers refer to it.

The references cited above do not disclose cooling the strip after application of the decorative material. Hasenkamp et al. discloses it is known

Art Unit: 1733

when applying thermoplastic to the edge of a workpiece to cool the material so that it does not penetrate too far into the edge of the workpiece.(Col. 3, ll. 16-23)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to cool the strip of material applied to the workpiece since this would prevent the material from penetrating too far into the workpiece.(Col. 3, ll. 16-23)

Regarding claim 10, while the reference is silent as to when the cooling takes place, one in the art would appreciate that the cooling would occur after application of the decorative material as otherwise the surface of the adhesive would have cooled too much to allow bonding of the decorative material to the extruded strip.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munro, Winterroth et al., and Nakata et al. as applied to claim 2 above, and further in view of Ecklund et al.

The references cited above do not disclose using a pair of driven roll to move the workpiece relative to the edge bander. Ecklund et al. discloses it is known to move a workpiece past an extruder which extrudes material on the edge by using a pair of driven rolls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to move the workpiece past the extruder since the device of Nakata et al. would not work well with a material like wood which is not easier held by suction cups and since Ecklund et al. discloses it is known to use driven rollers to move workpieces past an extruder.(Figure 1)

Response to Arguments

15. Applicant's arguments with respect to claims 1-4 and 7-11 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's argument that the references do not disclose a roller with a pattern of projections or recesses, Shanahan et al., Cakmakci et al., and Winterroth et al. all discloses a roller which applies a pattern to a material which is extruded onto a substrate.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1733


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571)-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BJM



BLAINE COPENHEAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700